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**REMARKS**

Reconsideration and allowance are requested. The Examiner rejected pending claims 1 - 53. No claims are amended.

A. **Rejection of Claims 1 – 4, 6-7, 10-17, 19-20, 23-30, 33-39, 42-48 and 51-53 rejected under 35 U.S.C. §103(a) as being unpatentable over Goetz (USP 5,928,330) in view of McCoy (USP 6,526,575B1)**

The Examiner rejected claims 1-4, 6-7, 10-17, 19-20, 23-30, 33-39, 42-48 and 51-53 as being unpatentable under Section 103(a) over Goetz in view of McCoy et al. Applicants traverse this rejection and respectfully submit that there is no motivation or suggestion to combine these references. Therefore, Applicants submit that these claims are patentable.

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purposes, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Further, if the proposed modification of the prior art would change the principle operation of the prior art invention being modified, then the teaching of the reference is not sufficient to

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render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). The principles outlined in both these cases are applicable here.

Goetz focuses his invention on a system for presenting multimedia data in a client-server context. His figure 9 shows the client and server connected by a network 930. This is an important factor in Goetz because his primary goal is to attach an importance to each unit of information, infer network conditions and then stream the units of multimedia information to the client at a streaming rate according to the importance of each unit and the inferred network conditions. See Abstract.

In contrast to the network-centric invention of Goetz, McCoy discloses a system for providing a multimedia broadcast system for transmitting multimedia contents from a central uplink facility 102 through a satellite 104 to a remote downlink facility 106. See FIG. 1. The downlink facility may be operated by a cable company that receives the multimedia content from the satellite and distributes it to cable subscribers. The purpose of McCoy is to provide a distribution and broadcast system where multimedia presentations at a subscribers home (viewed on a TV) can be improved by providing a diverse array of display arrangements and adding information and entertainment at the downlink facility for the cable subscribers. Col. 2, lines 37 - 45. There is no client-server context in McCoy and the only comparable structure is the uplink facility 102 which transmits through the satellite to the downlink facility 106.

There are numerous reasons why one of skill in the art would not be motivated to combine these references. When analyzing these references, Applicants note that the entire teachings of the references must be considered for their suggestive power including teachings away from any combination. For example, the technical structure of the Internet and the client-server networked computers differs from the uplink/satellite/downlink arrangement of McCoy. One of skill in the art would understand the technical difficulties in blending these two diverging systems. Another reason relates to the fact that Goetz's focus on inferring

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network conditions is useless and irrelevant in McCoy. The transmission medium of McCoy is a satellite uplink and downlink. In contrast to the Internet that connects a client computer to a server computer and which can experience traffic congestion, no such problem exists when transmitting data via an uplink to a satellite. Therefore, one of skill in the art, understanding that Goetz is about inferring network conditions and throttling down packets of data where necessary before transmission would be irrelevant to McCoy's disclosure about a satellite communication system.

The Examiner argues on page 4 that it would be obvious to modify Goetz with McCoy's teaching of requesting the display of presentation data as the quality of displaying data is of concern. Applicants submit that this would not be obvious. The reason is in McCoy, the presentation data is used by the remote downlink facility 106 to add presentation information such as background information to enhance the quality of the multimedia sequences by providing a variety of information. The information may be about sports, music, shows, etc. while running video clips. Col. 14, lines 30 - 35. The reason this presentation data is added by the remote downlink facility for cable subscribers is that the limited bandwidth for the satellite link prevents the transmission of such data. Therefore, this information as added by the local cable company to enhance the user experience. Col. 14, lines 24 - 42.

Applicants submit that, based on the preponderance of the evidence standard that the Examiner must apply to whether these references should be combined, it is more likely that one of skill in the art would not combine these references. One of skill in the art would recognize that there is simply no need within a client-server, Internet based context of Goetz to add (from a source such as the remote downlink facility) a variety of information related to sports, music, shows etc. The Internet already enables web pages to provide any kind of information desired. Therefore, if all that McCoy has to offer is the addition of some background image on a television to provide information about the movie or sporting event,

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Applicants respectfully submit that one of skill in the art would not look to a satellite/cable based disclosure like McCoy for such information.

Furthermore, even if McCoy were combined with Goetz, the combination would still fail to teach each claim limitation. The combination still fails to teach formulating at the receiver a media parameter suggestion for the encoder to alter the characteristics of data to be sent to the receiver. The Examiner points to columns 5, 7 and 10 - 14 asserting that McCoy teaches this claim limitation. However, nothing in McCoy matches this limitation. Each portion of McCoy cited by the Examiner will be addressed in turn:

(1) Col. 5, lines 29 - 40: This merely discusses various multimedia content from outside sources that are input to a capture unit 118 and converted to digital data for later broadcasting. Nothing related to the receiver formulating a media parameter.

(2) Col. 7, lines 9 - 28: This discloses preferences of broadcast operators at the downlink facilities and relates to the presentation information 202. This portion of McCoy is irrelevant because the presentation information comes from the remote broadcast operator and is transmitted to the user's television. There is no discussion of anything like formulating a media parameter at a user's TV (which in McCoy could relate to the "receiver") that is sent to the downlink facility.

(3) Col. 10, lines 34 - 41: This merely describes data specific to each of the broadcast operators remote downlink facilities. There is no discussion regarding formulating a media parameter suggestion for an encoder to alter characteristics of the data. The information here merely relates to the channel lineup, viewer information pages, local media and so forth for the broadcaster to use when communicating with its cable subscriber TVs.

(4) Col. 11, line 55 - Col. 12, line 67. This portion of McCoy merely discusses the promotion sequence and the promotion look of service rules. These relate to enabling the downlink facility to present commercials or other information at appropriate times. i.e., if the time is 10 minutes after the hour and the local confirmation video-insertion parameter equal

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to "yes." The promotion look of service rules will provide geometric layouts for how the final screens are viewed by the television viewers. There is no suggestion or discussion that any television as a receiver of content formulates a media-parameter suggestion for an encoder.

(5) Col. 13, line 40 - Col. 14, line 41: This portion of McCoy only discusses enhancing the viewing image for TVs via the addition of background material or other informational material that could not be transmitted via the satellite. The Examiner asserts that the viewer may use a back communication link for requested an updated display as shown in FIG. 1. However, this link 116 is only taught as being used by the download facility to transmit an error detection signal so that the uplink system retransmits. Col. 5, lines 20 - 28. Applicants cannot find any support for the Examiner's statement that the viewer (i.e., the user watching TV) may use link 116 to request an "updated display". McCoy only teaches transmitting an error signal from the downlink facility via link 116 to the upload facility to retransmit relevant data in the case of error. The data may be content or control information. The retransmitted data is not taught as being "updated display" data. See col. 5, lines 12 - 28.

Accordingly, Applicants submit first that there is no motivation or suggestion to combine Goetz with McCoy. Furthermore, even if combined, these two references fail to teach each limitation of claim 1. Given the preponderance of the evidence standard by which the Examiner must determine patentability, Applicants submit that this is a clear case where the preponderance of the evidences leads to a lack of motivation to combine. Therefore, claim 1 is patentable and in condition for allowance.

Claims 2 – 4, 6-7 and 10-13 each depend from claim 1 and recite further limitations therefrom. Accordingly, these claims are patentable as well.

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Claim 14 recites a method of transmitting data that is similar in scope to claim 1. Therefore, for the same reasons set forth above, claim 1 and dependent claims 15 - 17, 19-20, 23-26 are patentable.

Claim 27 and dependent claims 28 - 30 and 33-36 are patentable as well because there is no motivation or suggestion to combine Goetz with McCoy.

Claim 36 and dependent claims 37 - 39 and 42-45 are also patentable as well as claims 46 and its dependent claims 47 - 48 and 51-53.

**B. Rejection of Claims 5 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Goetz in view of McCoy as described above and Pocock (USP 5,014,1215)**

The Examiner rejects claims 5 and 8 over Goetz, McCoy and Pocock. Applicants traverse this rejection and submit that because of the argument set forth above regarding the lack of motivation or suggestion to combine Goetz with McCoy, that these claims are patentable.

**C. Rejection of Claims 8-9, 21-22, 31-32, 40-41 and 49-50 under 35 U.S.C. § 103(a) as being unpatentable over Goetz in view of McCoy and Volk (USP 5,673,401)**

The Examiner rejects claims 8-9, 21-22, 31-32, 40-41, and 49-50 as being unpatentable over Goetz in view of McCoy and Volk. Applicants submit that for the same reasons set forth above, namely that there is simply no motivation or suggestion to combine the client-server application of Goetz with the satellite distribution system of McCoy, these claims are patentable. Therefore, Applicants respectfully submit that these claims are patentable and in condition for allowance.

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**CONCLUSION**

Having addressed the rejection of claims 1 -53, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

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